

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : **10/670,486** Confirmation No. **8001**
Applicant : **DANNY BILBY, et al.**
Filed : **September 25, 2003**
TC/A.U. : **2143**
Examiner : **Nguyen, Phouc H.**
Docket No. : **199-0018US-D**
Customer No. : **29855**
Title : **SYSTEM AND METHOD OF MONITORING VIDEO AND/OR AUDIO
CONFERENCING THROUGH A RAPID-UPDATE WEBSITE**

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed to request reconsideration of to the Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) for Patent No. 7,574,472 issued 11 August 2009. A copy of a response to a previous request accompanies this paper and indicates that no fee is required for this request. Applicant further believes that no additional fees are due in connection with this response. However, should any fees or refunds be due, the Office is authorized to charge or credit such fees or refunds to Deposit Account No. 501922, referencing attorney docket number 199-0018US-D.

Remarks begin on page 2 of this paper.

REMARKS

Applicants have received an Issue Notification and a Determination of Patent Term Adjustment under 35 U.S.C. 154(b), for issued Patent No. 7,574,472 with issue date 11 August 2009, for the above referenced application. The calculated Patent Term Adjustment (PTA) is indicated as 1053 days. However, Applicants believe the calculated term adjustment should be 1689 days rather than the 1053 days indicated for the following reasons.

As currently codified, 35 U.S.C. § 154(b) provides three guarantees of patent term, two of which are at issue here. The first is found in subsection (b)(1)(A), the "[g]uarantee of prompt Patent and Trademark Office response." It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: fourteen months for a first office action; four months to respond to a reply; four months to issue a patent after the fee is paid; and the like. *See* 35 U.S.C. § 154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are called "A delays" or "A periods." The second provision is the "[g]uarantee of no more than 3-year application pendency." Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO. ¹ *See* 35 U.S.C. § 154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the "B delay" or the "B period". ("C delays," delays resulting from interferences, secrecy orders, and appeals, are similarly treated but were not involved in the patent applications underlying this suit.)

Wyeth v. Dudas, Civ. Action No. 1:07-cv-1492-JR, 2008 WL 4445642 D.D.C.

The pertinent dates for calculating the PTA for this case are as follows:

- 1) 9/25/2003 Application filing date;
- 2) 9/25/2006 Three years from filing (start of B time calculation);
- 3) 11/14/2007 Mailing date of first Office Action;
- 4) 10/9/2008 Notice of Appeal with Request for Pre-Appeal Conference;
- 5) 8/11/2009 Issue date of Patent 7,574,472.

There are several categories of time calculation set forth in 37 C.F.R. 1.703 under subheadings a-g. The pertinent subheading in this instance are “a” (A-Time) and “b” (B-Time). Applicant notes that A-Time and B-Time are not allowed to overlap.

A-Time Calculation

The time period set forth under 37 C.F.R. 1.703(a), A-Time, allows fourteen months from the filing date for the Office to issue a first Office Action. The 14 month date in this case was 11/25/2004 and the first office action was not mailed until 11/14/2007. As noted above, A-Time and B-Time cannot overlap. Therefore, because the B-Time began accruing on 9/25/2006 the A-Time allocated before the first Office Action is calculated as the duration between 11/25/2004 (14 month date) and 9/25/2006 (B-time initiation). This duration is **669 days**. There are no other periods of A-Time to consider in this case because no Appeal Brief was filed and no Request for Continued Examination was filed so the B-time period, as explained below, never stopped accruing after it initiated.

B-Time Calculation

The time period set forth under 37 C.F.R. 1.703(b), B-Time, allows for 3 years pendency of an application. In the instant case, this is represented by the duration between 9/25/2006 (3 years from filing) and 8/11/2009 (Issue date of Patent). This time period represents 1051 days. Note, according to 37 C.F.R. 1.702(e) the term of the patent shall be adjusted if the delays were caused by successful appellate review. Here, the Pre-Appeal conference caused prosecution to be reopened and that was the last action prior to issuing the Notice of Allowance. Therefore, the B-Time never stopped accruing after it initiated until the actual issue date. Therefore, the B-Time is **1051 days**.

Conclusion

A-Time of 694 days plus B-Time of 1051 days minus 56 days results in the correct calculation for PTA being 1689 days. Applicant respectfully requests that the PTA be adjusted to this number for the reasons stated above.

* * * * *

Respectfully submitted,

September 8, 2009

Date

/William M. Hubbard/

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OFFICE OF PETITIONS

In re Application of :
Biby et al. :
Application No. 10/670,486 : ON APPLICATION FOR
Filed: September 25, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 199-0018US-D :
Title: SYSTEM AND METHOD :
OF MONITORING VIDEO AND/OR :
AUDIO CONFERENCING THROUGH A :
RAPID-UPDATE WEBSITE :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed May 26, 2009. Applicant requests that the determination of patent term adjustment be increased by four hundred seventy-eight (478) days to one thousand, five hundred thirty-one (1531) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent

within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



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Senior Petitions Attorney
Office of Petitions